

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re REISSUE application of)
U.S. Patent No. 6,180,991)
Applicant: Shunpei YAMAZAKI) **Box Reissue**
Issued: January 30, 2001)
For: SEMICONDUCTOR HAVING)
LOW CONCENTRATION OF)
PHOSPHOROUS)

PRELIMINARY LETTER

Commissioner for Patents
Washington, D.C. 20231

Sir:

Background information regarding the prosecution history of U.S. Patent No. 6,180,991 to Yamazaki ('991 patent) is provided herein below to clarify the circumstances in which the errors arose, these errors serving as the basis for the present reissue application. Consideration of these remarks is respectfully requested.

The subject '991 patent issued on January 30, 2001 with claims 1 to 35 from application Ser. No. 08/426,235 ('235 application) filed on April 21, 1995. In the '235 application, a *Terminal Disclaimer* was filed on November 27, 1996 disclaiming the terminal part of the statutory term of any patent granted which would extend beyond the expiration date of the full statutory term of U.S. Patent No. 4,581,476, and further stating that the '235 application will be enforceable only for and during such period that it and prior U.S. Patents No. 4,581,476, No. 4,591,892, No. 5,349,204 and No. 5,315,132 are commonly owned.

During the course of prosecution, the claims of the '235 application were substantively amended rendering the *Terminal Disclaimer* unnecessary and inappropriate. Correspondingly, a *Petition Under 37 CFR 1.182 To Withdraw A Terminal Disclaimer* (hereinafter "*Petition to Withdraw*") was filed on April 8, 1999.

Claims of the '235 application were allowed and the issue fee paid so that the application issued as the subject U.S. Patent No. 6,180,991. Upon inspection of the front page of the issued '991 patent, the assignee discovered that the '991 patent was still subject to the *Terminal Disclaimer*. Upon further investigation of the prosecution history, it was uncovered that the *Petition To Withdraw* was not acted upon by the USPTO during the 21 months passage from the filing of the *Petition To Withdraw* in April 8, 1999, to the issuance of the '991 patent in January 30, 2001. Thus, it was uncovered that the '235 application had issued prior to the withdraw of the *Terminal Disclaimer*.

This discrepancy was brought to the attention of the USPTO through facsimile and verbal correspondences of March 12 and 13, 2001, respectively. The original *Petition to Withdraw* of April 8, 1999 was then dismissed by the Office of Petitions on May 10, 2001 stating that the requested relief cannot now be considered in view of the fact that '991 patent had issued. A subsequent *Request for Reconsideration of Decision on Petition* was filed on August 24, 2001 but was denied in a *Decision Denying Petition* of November 8, 2001 stating, in part, that the requested relief cannot be granted through a petition after a patent has issued.

Therefore, as stated in the *DECLARATION* submitted with the present reissue application, the errors upon which reissue is based are:

1. The error of the applicants in failing to ensure proper disposition of the *Petition to Withdraw* during the prosecution of the '235 application;

2. The error of the applicants in not withdrawing the '235 application from issuance under 37 CFR 1.313 before the payment of the issue fee;

3. The error of the applicants in not withdrawing the '235 application from issuance under 37 CFR 1.313 after the payment of the issue fee;

4. The error of the applicants in not deferring issuance of the patent under 37 CFR 1.314 until the outstanding *Petition to Withdraw* was considered; and

5. The error of the Examiner/USPTO in failing to consider and act upon the *Petition to Withdraw* filed 21 months prior to issuance of the subject '991 patent.

The above errors have resulted in rendering the subject '991 patent inoperative during its terminal part of the statutory term that extends beyond the expiration date of the full statutory term of U.S. Patent No. 4,581,476. In addition, the above errors have also resulted in the subject '991 patent inoperative in that it is only enforceable for and during a period that it and the U.S. Patents No. 4,581,476, No. 4,591,892, No. 5,349,204 and No. 5,315,132 are commonly owned. Furthermore, in failing to withdraw the *Terminal Disclaimer*, the applicant also believes the '991 patent is partly inoperative by reason that the patentee claimed less than the patentee had the right to claim in regards to the term of the '991 patent.

While MPEP § 1490 states that "it is unlikely that a recorded terminal disclaimer will be nullified" after a patent issues, nothing in this, or any other, section of the MPEP prevents the PTO from nullifying this terminal disclaimer. This application presents the very kind of unlikely case where the terminal disclaimer should be removed. Applicant made efforts to have the terminal disclaimer removed during the prosecution of the application to no avail but not because of the merits. Moreover, the Board of Patent Appeals and Interferences has removed a terminal disclaimer by way of a reissue application in an even less compelling situation.

The MPEP provides that “[i]t has been the Office position that reissue is not available to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent.” MPEP § 1490(B). Nevertheless, we believe, for the reasons discussed *infra*, that the terminal disclaimer recorded in the ‘991 patent may be properly withdrawn through a reissue application under 35 U.S.C. § 251.

The MPEP does provide that a terminal disclaimer may be nullified by way of a petition before issuance of a patent. *See* MPEP § 1490(A). As noted *supra*, the applicant did petition the USPTO to withdraw the terminal disclaimer prior to issuance of the ‘991 patent, but unfortunately, the petition was not considered until after the issuance of the ‘991 patent. Thus, this case does not squarely fall under either scenario discussed in MPEP § 1490(A)-(B). However, in a similar situation, the Board of Patent Appeals and Interferences in reissue examination of patent RE35,754 to Durckheimer et al. found that a reissue application proceeding was a proper mechanism to withdraw a terminal disclaimer from an issued patent. (*See Ex parte* Durckheimer et al., Appeal No. 94-2004, U.S. Application Ser. No. 07/551,615 (stating at 17-18 that “[t]o the extent that [Section 1490] is interpreted to mean that a reissue is never available for whatever reason to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent, we find this interpretation to be inconsistent with the provisions of 35 U.S.C. § 251.”)). A copy of the decision in *Ex parte* Durckheimer et al. is enclosed.

Furthermore, the reasons set forth in the MPEP for discouraging use of reissue proceedings to withdraw a terminal disclaimer do not apply in this case. The first reason stated in the MPEP is that the “granting of a reissue patent without the effect of the recorded terminal disclaimer would result in extending the term of the original patent, [and granting] reissue under these circumstances would be contrary to the statute.” MPEP § 1490(B). However, a terminal disclaimer does not alter the original patent term; it only disclaims a portion of that term. Hence, removing a terminal

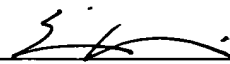
disclaimer only restores the patent term to its original length. Thus, a reissue to withdraw a terminal disclaimer would not extend the term of the original patent. *See ex parte Durckheimer et al.* at 19-20.

The second reason set forth in the MPEP for denying a reissue is that the removal of a terminal disclaimer would be contrary to the recapture principle. Generally, the recapture principle involves a change having been made to the scope of the patent claims. Because withdrawal of the terminal disclaimer would not modify any of the claims, recapture is also not an issue. *See also id.* at pg. 21.

The third reason set forth in the MPEP for not allowing a terminal disclaimer to be withdrawn by a reissue application is that a reissue cannot be used as a substitute for USPTO procedures. However, the applicant is not seeking to substitute reissue for USPTO procedures. The applicant attempted to remove the terminal disclaimer in the '991 patent prior to issuance by petition as suggested by the MPEP, but due to error on the part of the applicant and the USPTO, the procedures failed. *See also id.* at 21-25.

In light of the above, the applicant believes that the withdrawal of a terminal disclaimer from an issued patent through reissue application proceedings is proper, that such is appropriate in the case of the '991 patent, and examination on the merits and issuance of the subject reissue application is respectfully requested.

Respectfully submitted,



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